

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/924,265

Applicant(s)

HU ET AL.

Examiner

JEFFREY G. HOEKSTRA

Art Unit

3736

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 August 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 42, 43, 45-52 and 54-58.
Claim(s) withdrawn from consideration: 1-41.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Max Hindenburg/
Supervisory Patent Examiner, Art Unit 3736

/Jeffrey G Hoekstra/
Examiner, Art Unit 3736

Continuation of 11. does NOT place the application in condition for allowance because:

Applicant argues the Final Rejection of the claims mailed 06/04/08 as being unpatentable under 35 USC 103(a) as being obvious over Kauffman in view of John.

As an initial matter, the Examiner notes Applicant apparently mischaracterizes the rejection of claims 56 and 57 as being rejected under Kauffman in view of Miller. Claims 56 and 57 were rejected under Kauffman in view of John and in further view of Miller.

As a secondary matter, the Examiner notes Applicant erroneously mischaracterizes the rejection of the claims as stating "The Amendments Filed February 28, 2007 Were Not Considered". First the Examiner notes Applicant is apparently referring to the amendments filed 02/28/2008 and assuming arguing Applicant intended to argue such Applicant's attention is respectfully directed to paragraphs 3-19, especially paragraph 17, mailed 06/04/08 wherein the scope of the amended claims and the limitations positively recited therein were considered in their entirety in the rejection.

With regards to Applicants arguments that Kauffman does not disclose, teach, and/or fairly suggest (a) "a computer processor...programmed to stop a collection of data after the recording of a predetermined number of faults and programmed to stop the collection of data after the receiving an indication that the data collected is reliable" and (b) a "means for detecting electrical signals representative of [a] patient's evoked brain potentials" the Examiner maintains the rejection as mailed 06/04/08, especially paragraph 17 that states "Thus for claims 42, 43, 45-52, 54-55, and 58, Kaufman discloses the claimed invention except for expressly disclosing the means for detecting electrical signals representative of the patient's evoked brain potentials and the computer processor is programmed to stop a collection of data after a recoding of a predetermined number of recorded data faults and the computer processor is programmed to stop the collection of data after recording a predetermined number of reliable data. John teaches a system (10) for performing a medical examination, comprising inter alia: a means for presenting a series of sensory stimuli for perception by a patient (26); a means for detecting electrical signals representative of the patient's evoked brain potentials (28) (paragraph 127); a means for amplifying said signals (30); a means for converting said signals (18); a means for recording said data (34); a means for measuring said data (48); and a computer processor (12) programmed with software (50) configured to stop a collection of data after a recoding of a predetermined number of recorded data faults (paragraphs 125, 136, 144-148, 153, 154, 158, 170, 177, 187, 194, 204,207, 254-271,288, 297- 298, 300, 309, and 315) and the computer processor programmed with the software (50) configured to stop the collection of data after recording a predetermined number of reliable data (paragraphs 125, 136, 144-148, 153, 154, 158, 170, 177, 187, 194,204, 207, 254-271,288,297-298, 300, 309, and 315). All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention. All of the component parts are known in Kaufman and John. The only difference is the combination of the component parts into a single device. Thus, it would have been obvious to one having ordinary skill in the art at the time of the invention to combine the components as taught by Kaufman with the components as taught by John to achieve the predictable results of providing a programmed computer processor with increased data analysis capabilities to increase the diagnostic efficacy of a medical examination system."

With regards to Applicants arguments that Kauffman does not disclose, teach, and/or fairly suggest (a) or (b) and in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

With regards to Applicant's argument (b) and Applicant's erroneous assertions that "'Notwithstanding oversight of the claim term 'brain,' the Examiner is taking Official Notice that 'bio-electromagnetic signals generated by eye movements' are equivalent to 'evoked brain potentials.'" As such, pursuant to MPEP §2144.03, Applicants respectfully request that the Examiner provide documentary support for such Notice", the Examiner disagrees and directs Applicant's attention to paragraph 17 mailed 06/04/08 wherein Official Notice is not relied upon.